

Appl. No. 09/351,086
Amendment and/or Response
Reply to Office action of 23 August 2006

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REMARKS / DISCUSSION OF ISSUES

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Claims 1-2, 4-20 and 26-27 are pending in the application.

The Office action rejects claims 1-2, 4-10, 17-20, and 26-27 under 35 U.S.C. 103(a) over Hjelsvold et al. (USP 6,546,555, hereinafter Hjelsvold) and Nagasaka et al. (USP 6,400,890, hereinafter Nagasaka). The applicant respectfully traverses this rejection.

Claim 1, upon which claims 2-17 and 26-27 depend, claims a method for processing video that includes displaying a sequence of video segments at a display of a user, extracting a feature from one or more video segments of the sequence, determining an association between the feature and at least one additional information source also including that feature, and defining a link between the feature and the at least one additional information source to facilitate a display of information from the additional information source based at least in part on a selection by the user of the feature while the one or more video segments are displayed to the user.

The Examiner's attention is requested to MPEP 2142, wherein it is stated:

"To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) *must teach or suggest all the claim limitations*... If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The Office action acknowledges that Hjelsvold fails to teach or suggest extracting a feature from one or more video segments of the sequence and defining a link between the feature and the at least one additional information source to facilitate a display of information, and asserts that Nagasaka provides this teaching. The applicant respectfully disagrees with this assertion.

Nagasaka does not teach extracting a feature from video segments, as the term 'feature' is used in the rejection with regard to Hjelsvold. Nagasaka defines a feature as a characterization of a frame of video data, "such as the mean color of the whole frame image" (Nagasaka, column 5, lines 43-44). Throughout Nagasaka, the 'feature' is a characterization of the entire frame.

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It is well established that the terms of a claim are interpreted in the context of the specification. For example, the term "feature" is not found in Hjelsvold, but because Hjelsvold's selectable AIUs (Anchorable Information Units) appear to correspond to the elements that are termed 'features' in the applicant's specification, Hjelsvold's AIUs are considered in the Office action to be equivalent to the applicant's claimed feature elements. Correspondingly, the use of the term 'feature' in another reference does not imply equivalence unless the elements deemed to be 'features' in the other reference also appear to correspond to the elements that are deemed to be 'features' in the applicant's specification.

The rationale for a rejection must be consistent, and the terms used within the claim must be interpreted consistently. Nagasaka's features do not correspond to Hjelsvold's selectable AIUs, and thus a common reference to Nagasaka's features and Hjelsvold's AIUs as corresponding to the applicant's claimed features is inconsistent. Hjelsvold's feature is a discrete selectable object within an image frame, while Nagasaka's feature is a characterization of the entire image frame; these two definitions of feature are not equivalent and both definitions cannot be said to correspond to the applicant's claimed feature in a consistent interpretation of the applicant's claim. Assuming that Hjelsvold is deemed in the Office action as teaching the applicant's claimed feature, Nagasaka cannot also be deemed to teach the applicant's claimed feature.

Because the combination of Hjelsvold and Nagasaka does not teach or suggest extracting a feature from one or more video segments of the sequence and defining a link between the feature and the at least one additional information source to facilitate a display of information based at least in part on a selection by a user of the feature, as specifically claimed in claim 1, the applicant respectfully maintains that the rejection of claims 1-2, 4-10, 17, and 26-27 under 35 U.S.C. 103(a) over Hjelsvold and Nagasaka is unfounded per MPEP 2142.

In like manner, each of claims 18 and 19 includes a processor that is configured to determine an association between the feature and at least one

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additional information source also including that feature and to direct the display of information from the additional information source based at least in part on a selection by a user of the feature in the first video segment while the one or more video segments are displayed on the display. Claim 20 claims a software program that includes similar limitations.

Based on the remarks above, neither Hjelsvold nor Nagasaka teaches or suggests a processor or a computer program that determines an association between the feature and at least one additional information source also including that feature and directs the display of information from the additional information source based at least in part on a selection by a user of the feature, as specifically claimed in each of claims 18, 19, and 20. Therefore, the applicant respectfully maintains that the rejection of claims 18-20 under 35 U.S.C. 103(a) over Hjelsvold and Nagasaka is unfounded, per MPEP 2142.

Additionally, the Examiner's attention is requested to MPEP 2143, wherein it is stated:

"THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). ... The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)".

Also:

"When prior-art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must *suggest* the desirability, and thus the obviousness, of making the combination. It is impermissible to use the claims as a frame and the prior-art references as a mosaic to piece together a facsimile of the claimed invention." (emphasis added) *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art *suggested* the desirability of the modification." (emphasis added) *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

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There is no suggestion in the prior art to combine Hjelsvold and Nagasaka. Hjelsvold teaches a technique for the display of selective segments of video based on the classification (payment schedule) of the viewer. Nagasaka teaches a technique for finding a given sequence of frames within a target video stream.

The Office action asserts that one of skill in the art would be motivated to combine Hjelsvold and Nagasaka "in order to provide the user a sequence of video segments, extracting a feature from one or more video segments, defining a link between the feature and the at least one additional information related to the feature as preferred" (Office action, page 4, lines 8-10). The applicant notes, however, that this asserted motivation is found only in the applicant's disclosure, and not in either Hjelsvold or Nagasaka. The Office has done nothing more than paraphrase and repeat the applicant's disclosure and claims. The Office has not cited with particularity any column and line number in any of the references that suggests a combination of the references.

Because the prior art does not suggest the combination of Hjelsvold and Nagasaka, the applicant respectfully maintains that the rejection of claims 1-2, 4-10, 17-20, and 26-27 under 35 U.S.C. 103(a) over Hjelsvold and Nagasaka is unfounded, per MPEP 2143.

The Office action rejects claims 11-16 under 35 U.S.C. 103(a) over Hjelsvold, Nagasaka, and Jain et al. (USP 6,463,444). The applicant respectfully traverses this rejection.

Claims 11-16 are dependent upon claim 1, and in this rejection, the Office action relies upon Hjelsvold and Nagasaka for teaching the elements of claim 1.

As noted above, the combination of Hjelsvold and Nagasaka fails to teach each of the elements of claim 1, and additionally, or in the alternative, there is no suggestion in the prior art to combine Hjelsvold and Nagasaka. Therefore, the applicant respectfully maintains that the rejection of claims 11-16 under 35 U.S.C. 103(a) that relies on Hjelsvold and Nagasaka teaching the elements of claim 1 is unfounded, per MPEP 2142 and 2143.

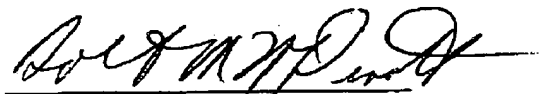
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In view of the foregoing, the applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Robert M. McDermott, Esq.
Registration Number 41,508
Phone: 804-493-0707

Please direct all correspondence to:

Yan Glickberg, Esq.
Philips Intellectual Property and Standards
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9618
Fax: (914) 332-0615